

Remarks:

Applicants have studied the Office Action dated October 18, 2007. By virtue of this amendment, claim 1 is hereby amended and claims 2-9 and 12-20 have been cancelled. New claim 21 is added. No new matter has been added. Based on the remarks below, it is submitted that the application is in condition for allowance. Reconsideration and reexamination are respectfully requested.

§112 Rejection(s):

The Examiner has rejected claim 1 under 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This ground of rejection is respectfully traversed.

The Examiner states that “in claim 1 it is unclear how the message is forwarded to the first system since the message already has stored within the first system. For purposes of this action, it is assumed the message is forwarded from the first system to the second system” (Office Action, pg. 2).

Applicant would like to point out that claim 1 discloses a method for automatically ordering, billing, and providing a service provided over a communications network from a first system to a second system, through the use of a third system which can act as an interface between the first system and the second system. The disclosed method comprises: “forwarding the message to the first system from the second system” (claim 1). There is nothing in claim 1 to suggest that the message is “already stored within the first system.” To the contrary, claim 1 explicitly states that a message is forwarded from the second system to the first system. This ground of rejection is respectfully traversed.

§102 Rejection(s):

The Examiner has rejected claims 1-7, 9, 12, 13, 15, 16, 18 and 20 under 35 U.S.C. 102(e) as being anticipated by *Uchida et al.* (2003/0233322). This ground of rejection is respectfully traversed.

Uchida discloses a billing system capable of simplifying a user's operation when the user is passing through a geographical billing zone. The *Uchida* system performs a billing process which initiates when a user passes through "an entry point terminal located at an entry point into the billing zone and configured to communicate with the mobile terminal by a short-range wireless, and an exit point terminal located at an exit point out of the billing zone and configured to communicate with the mobile terminal by a short-range wireless" (see paragraph [0024]).

Uchida fails to disclose a billing system which can be applied through the use of a third party portal, providing one or more services, as recited in the amended claims. The billing system disclosed by *Uchida* is a billing system applied to a billing scheme of determining a bill solely on the basis of entry into and exit from a particular billing zone.

The claims as amended are directed to ordering, billing, and providing a service provided over a communications network from a first system to a second system, through the use of a third system which can act as an interface between the first system and the second system, obviating the need for the user who is ordering the service to have preliminary knowledge of an ordering syntax or of the identifying code for the particular feature being ordered. *Uchida* teaches away from the recited features by suggesting that a "service code" is to be provided by the cellular phone (see [0079]).

Uchida also fails to teach or suggest a method or system for ordering a service provided over a communications network, the method comprising: selecting a first service to be provided by a first system to a second system, through a third system, the first system comprising a content provider, the second system comprising a wireless mobile communication device, the third system comprising a server connected to both the first system and the second system over a communication network, wherein the first service is provided to the second system via the third system, in response to the first system receiving from the third system ~~associated with a first code associated with the first service, wherein the first service comprises downloading content or software code from the first system to the second system for enhancing functionality of the second system, and wherein a software application executing on the second system enables a~~

user to browse a graphical user interface menu provided by the first system to download content associated with the first service without manually entering the first code, wherein the first code is included in a text message generated by the software application in response to a user selecting the first service by interacting with the graphical user interface menu, wherein the text message is transmitted to the first system by way of the third system, wherein the third system generates a bill transmitted to the first system, in response to content associated with the first service being downloaded to the first system.

In the light of the above it is respectfully submitted that the billing and ordering system and method for services provided over communications networks as presented in the amended claims are patently distinguishable from the cited 102 reference and are therefore in condition for allowance.

§103 Rejection(s):

The Examiner has rejected claim 8 under 35 U.S.C. 103(a) as being unpatentable over *Uchida et al.* in view of the Examiners Official Notice. The Examiner has further rejected claims 10-11, 14, 17 and 19 under 35 U.S.C. 103(a) as being unpatentable over *Uchida et al.* (2003/0233322) in view of *Lamb et al.* (6,747,970). These rejections are respectfully traversed.

MPEP §2143 provides:

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

For the reasons stated above, *Uchida* is an improper reference because it fails to teach or suggest all the elements of claim 1 and further because *Uchida* teaches away from the claimed invention. Therefore, it would be unreasonable to suggest that a person of ordinary skill would

be motivated to combine *Uchida* with any other reference. Accordingly, it is respectfully requested that the §103 ground of rejection be withdrawn.

Lamb fails to cure the deficiencies of *Uchida* as *Lamb* either alone or in combination with *Uchida* fails to teach or suggest a system or method for selecting a first service to be provided by a first system to a second system, through a third system, the first system comprising a content provider, the second system comprising a wireless mobile communication device, the third system comprising a server connected to both the first system and the second system over a communication network, wherein the first service is provided to the second system via the third system, in response to the first system receiving from the third system associated with a first code associated with the first service, wherein the first service comprises downloading content or software code from the first system to the second system for enhancing functionality of the second system, and wherein a software application executing on the second system enables a user to browse a graphical user interface menu provided by the first system to download content associated with the first service without manually entering the first code, wherein the first code is included in a text message generated by the software application in response to a user selecting the first service by interacting with the graphical user interface menu, wherein the text message is transmitted to the first system by way of the third system, wherein the third system generates a bill transmitted to the first system, in response to content associated with the first service being downloaded to the first system.

While the suggestion to modify or combine references may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998).

Here, the modification or combination proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion

and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Appellant's disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. § 103. *In re Geiger*, 2 USPQ2d 1276 (Fed. Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a prima facie case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicant invites the Examiner to point out the alleged motivation to combine with specificity,¹ or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.²

Since no reasonable justification is provided in the Office Action as to how such modification or combination is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the §103 ground of rejection be withdrawn.

For the above reasons, neither *Uchida* nor *Lamb*, either alone or in combination, teach or suggest the invention as recited in claim 1. Therefore, it is respectfully submitted that claim 1, as amended, is in condition for allowance. Claims 10 and 11 depend on claim 1 and should be in condition for allowance by the virtue of their dependence on an allowable base claim.

¹ *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

² "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (310) 789 - 2100 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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